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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/797,756	03/10/2004	Daniel James Plant	1315-22	4239
7590	04/19/2007		EXAMINER	
David M. Carter Carter, DeLuca, Farrell & Schmidt, LLP Suite 225 445 Broad Hollow Road Melville, NY 11747			JUSKA, CHERYL ANN	
			ART UNIT	PAPER NUMBER
			1771	
SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE		
3 MONTHS	04/19/2007	PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)
	10/797,756	PLANT, DANIEL JAMES
	Examiner Cheryl Juska	Art Unit 1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 29 January 2007.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 62-99 is/are pending in the application.
 4a) Of the above claim(s) 71,72 and 76-99 is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 62-70 and 73-75 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>01/07</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's amendment filed January 29, 2007, is entered. Claims 1-61 have been cancelled. The specification and claims 69, 70, and 73-75 have been amended as requested. The pending claims are 62-99, with claims 71, 72, and 76-99 being withdrawn as non-elected. Thus, the claims pending for examination on the merits are 62-70 and 73-75.
2. Said amendment to the specification is sufficient to overcome the objection to the specification as set forth in section 5 of the last Office Action (Non-Final mailed 07/28/06). Additionally, it is noted that the substitute specification filed with the original papers on 03/10/04 renders moot the objection to the specification as set forth in section 4 of the last Office Action.
3. The amendments to the claims are sufficient to overcome the 112, 2nd rejections set forth in sections 7-12 of the last Office Action.
4. Applicant's arguments with respect to the prior art rejection based upon Dischler (US 5,776,839) (Amendment, page 17, 4th paragraph – page 18, 2nd paragraph) have been found persuasive. As such, the rejection set forth in section 19 of the last Office Action is hereby withdrawn.

Claim Objections

5. Claims 62 and 73-75 stand objected to because of the following informalities: the misspelling of "dilatant" as "dilatent." For consistency, appropriate correction is required.

Double Patenting

6. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

7. Applicant is advised that should claim 73 be found allowable, claim 75 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 112

8. Claim 69 stands rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement as set forth in section 14 of the last Office Action. Applicant asserts the amendment changing the claim recitation from "wherein the outer surface of each covering layer *is formed with* a plurality of compressible bubbles therein" to "wherein the outer surface of each covering layer *includes* a plurality of compressible bubbles therein" is sufficient to overcome said enablement rejection. Specifically, applicant states "one of ordinary skill in the art would in fact know how to provide a cover layer having a plurality of compressible bubbles therein" (Amendment, paragraph spanning pages 13-14). However, this argument is an

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unsupported assertion. Applicant does not point to the disclosure of the specification for an explanation of enablement. Nor does applicant explain why or how one skilled in the art would “in fact know how to provide” said cover layer. Also, note the change in claim language from “*is formed with*” to “*includes*” does not address the enablement rejection. As such, the 112, 1st enablement rejection is hereby maintained.

Claim Rejections - 35 USC § 102

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

10. Claims 62-64, 73, and 75 stand rejected under 35 USC 102(b) as being anticipated by GB 2 349 798 issued to Plant as set forth in section 16 of the last Office Action.

Applicant traverses the anticipation rejection by arguing that Plant teaches a single flexible envelope rather than “multiple voids or cavities which are not discrete/separate or spaced from each other but are instead continuous in nature” so that “the dilatant material may move between voids or cavities as needed in order to absorb the force applied thereto” (Amendment, page 14, 3rd paragraph and paragraph spanning pages 14-15). In response, it is noted that the features upon which applicant relies (i.e., multiple voids that are continuous in nature so that the dilatant material may move between voids or cavities) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Therefore, the rejection is maintained.

11. Claims 62-64 and 73-75 stand rejected under 35 USC 102(e) as being anticipated by US 2005/0037189 issued to Palmer et al.

Applicant traverses the Palmer rejection by asserting the reference is not available as 102(e) art due to applicant's effective filing date of September 13, 2001, which is the filing date of the priority documents for PCT/GB02/04209, from which the present application claims priority to (Amendment, page 15, 4th paragraph). The examiner respectfully disagrees.

First, the present application is not an application filed under 35 USC 371. Rather, the present application merely claims foreign priority to said PCT/GB02/204209 document. While the oath/declaration originally filed with the present application on 03/10/2004 states said application is a national stage of a PCT application, applicant failed to provide the proper papers for obtaining entry into the national stage. Note the requirements set forth in 35 USC 371, 37 CFR 1.491, 37 CFR 1.495, and MPEP 1893, especially MPEP 1893.01(a)(1). As such, the present application merely claims foreign priority to the PCT application and its foreign priority filing date of 09/13/2002.

Secondly, it is now noted that applicant's claim to the foreign priority date of 09/13/2002 is not granted since a claim for priority under 35 U.S.C. 119(a)-(d) cannot be based on a foreign application that was filed more than twelve months before the United States application was filed (03/10/2004).

Thirdly, without a claim to the foreign priority date of the PCT application, the earlier filed GB applications are also not granted priority. Hence, the effective filing date of the present application is its filing date of 03/10/2004. Therefore the Palmer reference is available as prior art under 102(e) and the above rejection stands.

Please note that applicant must amend the specification to delete the reference to foreign documents which have not been granted priority. Additionally, a new corrected oath, declaration or application data sheet is required in the body of which the present application should be identified by application number and filing date.

12. Claims 62-64 and 73-75 stand rejected under 35 USC 102(e) as being anticipated by US 6,701,529 issued to Rhoades et al. as set forth in section 18 of the last Office Action.

As with the Plant rejection, applicant argues features which are not presently claimed. The features upon which applicant relies (i.e., exiting containment without rupture thereof) are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Therefore, the rejection is maintained.

Claim Rejections - 35 USC § 103

13. Claims 65-68 and 70 stand rejected under 35 USC 103(a) as being unpatentable over the cited Palmer reference in view of US 5,589,245 issued to Roell.

Applicant has not presented any new arguments with respect to the 103 rejection but, rather merely relies upon the traversal of the 102 rejection by Palmer. Since said traversal has been found unpersuasive, the above 103 rejection is also maintained.

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Juska whose telephone number is 571-272-1477. The examiner can normally be reached on Monday-Friday 10am-6pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached at 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



CHEYL A. JUSKA
PRIMARY EXAMINER

cj
April 12, 2007